

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NIAN-HUA OU

Appeal No. 2004-0418
Application No. 09/457,183

ON BRIEF

Before PAK, WALTZ, and TIMM, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 3 and 11 through 14, which are the only claims remaining in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a paper overlaid wood board comprising an oriented strand board (OSB) core with a resin impregnated paper overlay adhesively secured to the top surface of the OSB core (Brief, page 3). Further details of

the invention may be ascertained from representative independent claim 1, reproduced below:

1. A paper overlaid wood board comprising:

an oriented strand board core having a bottom surface and a top surface, said oriented strand board core including a plurality of strands, each of said strands being generally oriented parallel to one another;

a resin impregnated paper overlay adhesively secured to said top surface of said oriented strand board, said paper overlay having a basis weight of about 25 lbs./msf to about 75 lbs./msf and a resin content of about 20% to about 60% by dry weight.

The examiner has relied upon the following references as evidence of obviousness:

Lindquist et al. (Lindquist)	5,718,786	Feb. 17, 1998
Tingley	5,885,685	Mar. 23, 1999
Jaffee et al. (Jaffee) (filed Dec. 31, 1998)	6,187,697 B1	Feb. 13, 2001

Claims 1-3 and 11-14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jaffee in view of Tingley and Lindquist (Answer, page 3).¹ We reverse the rejection on appeal for the reasons set forth below.

¹The examiner has separately rejected claim 13 under the same ground and the same references (Answer, page 4). Since this latter rejection is subsumed by the former rejection, we need only discuss the former rejection.

OPINION

The examiner finds that Jaffee discloses a multiple layer laminate comprising an oriented strand board substrate and resin saturated paper adhesively secured with a basis weight of 18 lbs./msf and a resin content of 20-22.5 wt.% (Answer, page 3, citing col. 9, ll. 35-51; col. 3, l. 63-col. 4, l. 54; and col. 6, ll. 5-13).² The examiner concedes that Jaffee does not disclose the basis weight as recited in claim 1 on appeal (Answer, page 3). However, the examiner finds that such ranges of weights are result effective variables which would have been easily optimized by one of ordinary skill in this art, and thus the claimed basis weight and paper overlaid wood board would have been obvious (Answer, pages 4-7). We disagree.

It is well settled that the discovery of the optimum value of a result effective variable is ordinarily within the skill of the art, if the parameter optimized was recognized to be a result-effective variable. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8-9 (CCPA 1977); and compare *In re Sebek*, 465 F.2d 904, 907, 175

²It is not contested that the disclosure by Jaffee of a basis weight of 1.8 lbs. per 100 square feet is equivalent to 18 lbs./msf (Answer, page 5; Brief, page 7).

USPQ 93, 95 (CCPA 1972). However, as correctly argued by appellants (Brief, page 5), the examiner has not shown that Jaffee teaches a paper overlay having a basis weight of about 25 to 75 lbs./msf as required by claim 1 on appeal. The examiner has failed to point to any disclosure or suggestion in Jaffee of a *paper* overlay, merely citing examples of Jaffee directed to *glass* fibers with a basis weight of 18 lbs./msf (col. 6, ll. 5-6), 18.3 lbs./msf (col. 6, ll. 54-55), and 19.2 lbs./msf (col. 7, ll. 31-32) (Answer, pages 3 and 6). The examiner has not established, by convincing evidence or reasoning, why the optimization of the basis weight of glass fiber mats would have suggested the claimed basis weight for a resin impregnated paper overlay.

For the foregoing reasons, we determine that the examiner has not established a *prima facie* case of obviousness in view of Jaffee. We note that Tingley and Lindquist were cited by the examiner merely to show the limitations recited in claims 12 and 13, respectively, and do not remedy the deficiency in the examiner's rejection as discussed above (Answer, page 4; see the final rejection dated Jun. 6, 2002, Paper No. 8, page 3). Accordingly, we also determine that the examiner has not established a *prima facie* case of obviousness in view of the applied prior art as a whole. Therefore the examiner's rejection

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of the claims on appeal under 35 U.S.C. § 103(a) over Jaffee in
view of Tingley and Lindquist is reversed.

The decision of the examiner is reversed.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
CATHERINE TIMM)	
Administrative Patent Judge)	

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